

January 13, 2005

REMARKS

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-33 are pending. In this Amendment, claim 26 is combined with claim 25 and cancelled and claims 1 – 25 and 27 – 33 are amended. No new matter is added.

Support for the amendment to claims 1 and 18 is found in the specification at Page 6, lines 21 – 23, as well as elsewhere in the originally filed specification drawings, and claims.

Double Patenting

The Examiner has provisionally rejected claim 1-33 under the judicially created doctrine of obviousness-type double patenting as being upatentable over claim 17 – 50 and 1 – 63 of co-pending application 09/977,667 and 09/977,547 respectively. Per the Examiner's request, the undersigned is a terminal disclaimer under separate cover.

35 U.S.C. §112

Claims 1-33 are rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner has stated that the preambles of the independent claims 1 and 18 are directed to means for diagnostic testing while the dependent claims fail to claim the means for diagnostic testing. The Examiner has suggested that the preamble be amended to be directed to a system for sample collection.

Claims 1 and 18 have been amended accordingly.

35 U.S.C. §102

Claims 1 – 33 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by U.S. Patent No. 4,293,074 to Dunskey ("Dunskey") or U.S. Patent No. 4,226,328 to Beddow ("Beddow"). This rejection is respectfully traversed with respect to the claims as currently presented.

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The Dunsky patent refers to a root canal treatment kit that contains the medications and implements, each placed within the appropriate recess, required to complete a root canal. Although each of the recesses is separated from the adjacent recess by raised projections or non-recessed portion, there are no teachings in the Dunsky patent regarding the physical separation of the wells or recesses.

Independent claims 1 and 18 have been amended to clearly state that the separator enables the carrier to be broken into two separate portions. The Dunsky patent would have no reason to teach or suggest the inclusion of a separator that would enable a portion of either the upper tray 12 or lower tray 11 to the ability to separate from the remaining tray. In fact, as the Dunsky patent makes no reference to a separate support for either of the trays, any area having a decreased density sufficient to enable the separation of one tray from the would be adverse to the concept of the invention. The Dunsky patent requires the strength and stability of the trays to hold medication and instruments; adding separator, without a redesign of the overall carrier, would prevent the Dunsky patent from being used for its intended purpose.

The Beddow patent is also to a carrier for instruments with the inner tray nesting within the outer tray. Like the Dunsky carrier, providing a means to separate a portion of either one of the trays from itself would be adverse to the intent of the patent.

Conversely, as the instant invention is being used for sample collection, it is frequently beneficial for the wells used in the testing to be separated. This is taught within the instant specification at page 7, lines 19 – 32 and page 8, lines 1 – 5.

With respect to the specimen tool, it is submitted that the tool is not claimed on its own but rather in combination with a novel, separable carrier.

Claims 2, 6, 7-11, 19, 25, and 27 depend directly or indirectly from claim 1, and, accordingly, include all of the patentable features of claim 1 as well as other patentable features. Therefore, claims 2, 6, 7-11, 19, 25, and 27 are patentable over Dunsky and Beddow for at least the reasons discussed above with respect to claim 1.

Claims 1-10, 12-26 and 28-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,339,955 to Horan *et al* ("Horan") or U. S. Patent 4,160,505 to Rauschenberger ("Rauschenberger"). This rejection is respectfully traversed with respect to the claims as currently presented.

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Horan relates to a medical instrument tray having depressions at each end and medical instrument holders in the middle portion. This patent is, as were the aforementioned patents, teaching a holder with wells that are separated by material or distance, not capable of being physically separated. Additionally, as in the aforementioned cited patents, not only is there a lack of teaching, or suggestion thereof, toward a tray where one portion can be separated from the remaining portion, it would be most likely adverse to the intended use of the Horan tray, which is to reliably carry instrument and medications.

The Rauschenberger patent discloses a cauterization tray and, like the previously cited patents, does not provide the teaching that it would be in any way beneficial to separate one portion of the tray from another portion.

It is submitted that the currently pending claims clearly set forth that the wells are able to be physically moved apart. With respect to the specimen handling tool, in both independent claims 1 and 18 the tool is part of the system that includes the novel carrier that can be separated into two separate sections. Therefore, it is respectfully submitted that all claims relating to the specimen handling tool must be read in conjunction with the novel carrier and that the portion of the claim referring to the tool cannot be isolated from the remainder of the claim.

35 U.S.C. §103

The Examiner has noted that the application currently names joint inventors. Applicant confirms that the subject matter of the various claims was commonly owned at the time the inventions covered in the pending claims were made.

Claims 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horan or Rauschenberger in view of Dunsky or Beddow. As stated supra, the specimen handling tool in the independent claims is part of the system which also includes a carrier having the ability to be separated into two portions.

In view of the foregoing Remarks and claim amendment is it respectfully requested that the currently cited art be withdrawn.

In an Office Action received on co-pending case, S. N. 09/977,539 cited Pasco® Panels from a Difco Laboratories catalog (copy enclosed) showing a variety of panels placed together for the picture. On Difco's website (www.difco.com) there is no mention of the wells within the panels separating. In a web search for Pasco® panels, there was

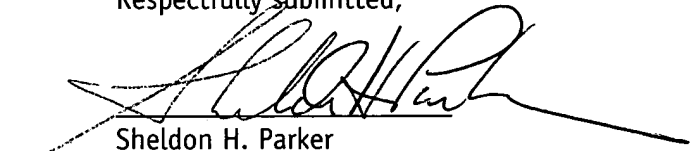
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an article in the BD Newsletter, Lab-O, volume 11, number 2 at page 5 (copy enclosed) (E Biosciences, 7 Loveton Circle, Sparks, MD 21152) making reference to the panels and the fact that they utilize a 104 well format vs. the traditional 96 well format. There is no mention within that article or on the Difco website that the cells separate from one another. It is therefore submitted that without evidence from the manufacturer to the contrary that the panel does not cells do not separate.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Sheldon Parker at 703-563-2041.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,



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